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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/748,209

12/31/2003

Paul A. Puniello

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08/01/2006

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EXAMINER

HUNTER, ALVIN A

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/748,209

Applicant(s)

PUNIELLO ET AL.

Examiner

Alvin A. Hunter

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 15-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 6, and 8-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Kennedy, III et al. (USPN 6790149).

Regarding claim 1, Kennedy, III et al. discloses a golf ball having a core and a cover wherein the golf ball may comprises one or more cover and/or mantle layers (See Column 23, lines 5 through 19). Kennedy, III et al. also notes that the cover layer can be transparent in order to highlight the coloring of the mantle layer. Kennedy, III et al. also notes that a two piece cover can also refer to an outer cover and a mantle layer (inner cover layer) and the inner cover layer comprising a first material and the outer cover layer comprising a second material (See Column 9, lines 53 through 58). Based on the above, a core, mantle and a cover meets the structure of the golf ball claimed by the applicant and, therefore, anticipates the instant claim.

Regarding claim 6, Kennedy, III et al. discloses the outer cover being harder than the inner cover (See Column 15, lines 24 through 31).

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Regarding claim 8, Kennedy, III et al. discloses the difference between the hardness of the inner cover layer and the outer cover layer being greater than 5 (See Paragraph bridging columns 10 and 11 and Column 15, lines 15 through 23).

Regarding claim 9, Kennedy, III et al. discloses the difference between the hardness of the inner cover layer and the outer cover layer being less than 25 (See Paragraph bridging columns 10 and 11 and Column 15, lines 15 through 23).

Regarding claim 10, Kennedy, III et al. discloses the difference between the hardness of the inner cover layer and the outer cover layer being less than 15 (See Paragraph bridging columns 10 and 11 and Column 15, lines 15 through 23).

Regarding claim 11, Kennedy, III et al. discloses the difference between the hardness of the inner cover layer and the outer cover layer being less than 10 (See Paragraph bridging columns 10 and 11 and Column 15, lines 15 through 23).

Regarding claim 12 and 13, see the above regarding claim 1.

Regarding claim 14, Kennedy, III, et al. discloses a layer over the cover (See Column 34, lines 5 through 16).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy, III et al. (USPN 6790149).

Regarding claims 2, 3, 4, and 5, Kennedy, III et al. does not explicitly disclose the inner layer being thicker than the outer layer. The applicant only discloses the thickness being critical for the aesthetic appearance of the dimples. The applicant does not disclose any utility to the thickness of the layers. Kenney, III et al. discloses the inner and outer cover layers having a thickness of 0.0005 to 0.15 inch and notes that the outer cover may be transparent to highlight the appearance of the inner cover layer (See Column 10, lines 49 through 58; Column 15, lines 15 through 23; and Column 23, lines 5 through 19). Kennedy, III et al. also notes that the dimples are present on the outer cover also. One having ordinary skill in the art would have found it obvious to have the inner and outer cover layers of Kennedy, III et al. to be of any thickness within the above ranges so long as the outer cover layer highlights the appearance of the inner cover layer.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy, III et al. (USPN 6790149) in view of Sullivan et al. (USPN 6905648).

Regarding claim 7, Kennedy, III et al. does not disclose the values of the outer and inner cover layers' hardness when the outer cover layer is harder than the inner cover layer. Sullivan et al. discloses a golf ball having a core and a two piece cover layer wherein the outer cover is harder than the inner cover (See Abstract). The inner cover has a Shore D hardness of 50 or less and the outer cover has a Shore D hardness of 60 or more (See Column 7, lines 13 through 25; Column 22, lines 55 through 65). One having ordinary skill in the art would have found it obvious to have the

outer cover harder than the inner cover as taught by Sullivan et al., in order to improve the COR and spin rate of the golf ball.

Response to Arguments

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim, can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAH

Alvin A. Hunter, Jr.



EUGENE KIM
SUPERVISORY PATENT EXAMINER